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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202562
Party	Plaintiff Boston Athletic Association
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Boston Athletic Association,)	
)	
Opposer)	
)	
v.)	Opposition No. 91/202562
)	
Velocity, LLC,)	
)	
Applicant)	

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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OPPOSER'S REPLY TO APPLICANT'S BRIEF

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Opposer hereby submits its reply to Applicant's Brief and in support of its opposition to refuse registration to Application Serial No. 85224698 for the mark MARATHON MONDAY for "clothing, namely, tops, bottoms, headwear, sweatshirts, sweat pants, jackets, pullovers, caps, hats, socks" in the name of Velocity, Inc.

FACTUAL BACKGROUND

This is a case in which the Applicant sought to connect itself with the Opposer and the marathon Opposer operates by providing clothing of the type typically provided by Opposer or its licensees under a name that falsely suggests an association or connection with the Opposer.

STATEMENT OF THE ISSUES

Whether Applicant's mark falsely suggests a connection with Opposer, in violation of Section 2(a) of the Lanham Act.

OPPOSER HAS MET ITS BURDEN THAT APPLICANT'S MARK SHOULD BE REFUSED REGISTRATION BECAUSE IT FALSELY SUGGESTS A CONNECTION WITH OPPOSER.

Under Section 2(a) of the Lanham Act, a mark shall be refused registration if it "[c]onsists of or comprises ... matter which ... falsely suggests a connection with persons, living or dead, [or] institutions. 15 U.S.C. § 1052(a). Applicant's Mark should be refused registration under Section 2(a) because it falsely suggests a connection with the Boston Marathon and the Opposer, the Boston Athletic Association.

In order to show false suggestion of a connection, the Opposer must show:

- (1) that applicant's mark is the same or a close approximation of opposer's previously used name or identity;
- (2) that applicant's mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to opposer;
- (3) that opposer is not connected with the goods that are sold or will be sold by applicant under his mark; and
- (4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on his goods, a connection with opposer is presumed.

See, *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956 (TTAB 2007) and *Buffet v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428, 429 (T.T.A.B. 1985). Opposer has met its burden of proof for these issues.

Opposer has shown that the applied for mark is the same or a close approximation of Opposer's previously used identity.

As noted in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985):

The starting point of our analysis on this issue rests with the opinion of the Court of Appeals for the Federal Circuit in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed.Cir. 1983), aff'g 213 USPQ 594 (TTAB 1982). Judge Nies, writing for the Court, reviewed the legislative history and common law origins of Section 2(a) of the Lanham Act. As Judge Nies noted, that portion of Section 2(a) respecting the "false suggestion of a connection" evolved out of, and embraced, the then nascent concepts of the rights of privacy and publicity. Because these rights protect an individual's control over the use of his "identity" or "persona", the elements of a claim of invasion of privacy and, consequently, of "false association", have emerged as distinctly different from the elements of a claim of trademark or trade name infringement. See *Notre Dame*, id. 217 USPQ at 509. A party acquires a protectable interest in a name (or its equivalent) under Section 2(a) where the name claimed to be appropriated points uniquely and unmistakably to that party's personality or "persona". A party's interest in such a name or designation does not depend for its existence on the adoption and use of a technical trademark. *Notre Dame*, id. 217 USPQ at 508-509. Thus, an opposer in a proceeding of this character may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner. See, *Notre Dame*, id. 217 USPQ at 508. Similarly, though there may be no likelihood of confusion as to the source of the goods, even under a theory of sponsorship or endorsement, nevertheless an opposer's right to control the use of its identity may be violated. *Notre Dame*, id. 217 USPQ at 509.

(emphasis provided)

Opposer has organized and operated the Boston Marathon for over 100 years, since 1897. See, *Fleming Deposition Page 17, lines 8-12*. "The Boston Marathon is the oldest and most prestigious marathon, and draws runners from well over 180 countries." See, *Fleming Deposition Exhibit 2*. "The Boston Marathon was originally a small local event ...this small New England spectacle has grown to become a race known 'round the world." See, *Fleming*

Deposition Exhibit No. 17. Because Opposer has organized and operated the Boston Marathon for this length of time, and because of the fame of this race, the public identifies the Boston Marathon with the Opposer, the Boston Athletic Association. The name Boston Marathon is the equivalent, and the public face, of the Opposer. *See, Fleming Deposition Page 25, lines 9-18.*

It appears that Applicant does not deny that the phrase "MARATHON MONDAY" has come to refer to and define the day on which the Boston Marathon is held. Applicant contends, however, that the Opposer is the Boston Athletic Association, and not the Boston Marathon, and therefore, the term MARATHON MONDAY is not the identity of the Opposer. Opposer submits that the Boston Athletic Association and the Boston Marathon are the same commercial enterprise, and, in the minds of the public are not separable. *See, Buffet v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428 at 430.

The Applicant argues that Opposer has not provided any evidence to support a contention that MARATHON MONDAY is the same or a close approximation of its identity or persona, Boston Athletic Association, but this is not true. *See, for example, Fleming Deposition Page 25, lines 9-18.* The Applicant dismisses Opposer's rights in its mark BOSTON MARATHON. Nonetheless, Opposer's previously used identity is its BOSTON MARATHON mark, and MARATHON MONDAY refers specifically to, and is synonymous with, the Boston Marathon. *See, for example, Fleming Trial Exhibit Nos. 13 and 14, Fleming Deposition Page 25, lines 7-8.*

Opposer has shown that Applicant's mark points uniquely and unmistakably to the Opposer

The evidence provided by Opposer shows that Opposer has used the phrase "Marathon Monday" in connection with the provision of its services. More importantly, the evidence shows that "Marathon Monday" is known to the public as the day of the Boston Marathon. Because the Boston Marathon is the only major marathon held on a Monday, the mark "MARATHON MONDAY" has been used by Opposer and by others to refer to the Opposer and its Boston Marathon, and the provision of goods and services by Opposer and/or its licensees since at least the mid 1970's. *See, Notice of Opposition, Allegation 7, Opposer's Trial Exhibit 11 and 12 and Fleming Deposition Exhibits 2 and 14.* The mark MARATHON MONDAY is used by government (*See, Opposer's Trial Exhibits 1, 22, 24, and 26 and Fleming Deposition Exhibit 4*), the media (*See, Opposer's Trial Exhibits 5, 7, 9, 10, 13, 15, 17, 18, 19, 20, and 21 and Fleming Deposition Exhibits 9, 16, 19, 10, 22, 23, 24*) and by runners and the public, all to refer to the

Opposer and its Marathon (*See, Opposer's Trial Exhibits 2, 3, 6, 16, 25, and 27 and Fleming Deposition Exhibits 7 and 13*). Merchants use the phrase to promote their goods and services for the day of the Opposer operates its Boston Marathon (*See, Opposer's Trial Exhibits #4, 8, and 23 and Fleming Deposition Exhibits 3, 5, 8, 10, 11, 12, 15, 17, 18, 21, 25*).

The phrase "Marathon Monday" is not a name or identity associated with the Opposer solely in Boston or even in Massachusetts. Because of the history of the running of the Boston Marathon, and because it attracts runners, media and spectators from around the country and around the world, the phrase "Marathon Monday" is used by Opposer and by others in connection with the Boston Marathon, the Boston Marathon festivities and the promotion of various goods and services. For example, students at Arizona State University celebrate the Boston Marathon with their own "Marathon Monday" celebrations. *See, Opposer's Trial Exhibit No. 2*. Similarly, media all over the country use "Marathon Monday" to identify the Opposer and the Boston Marathon festivities. (*See, Opposer's Trial Exhibits No. 7 and Fleming Deposition No. 13* [writers in Scottsdale Arizona], *Nos. 18, 19 and 20* [a national magazine headquartered in Pennsylvania], *No. 27* [a national magazine headquartered in San Diego, California], *Fleming Deposition Exhibit 16* [Smithsonian Student Traveler], *Fleming Exhibit 19* [the Daytona Beach Morning Journal], *Fleming Deposition Exhibit 20* [the Star Bulletin, Hawaii]). The phrase "Marathon Monday" is known nationwide (and internationally) to sports and running enthusiasts and to the public to identify the Opposer, its goods and services, and to identify the Boston Marathon and its associated activities.

These materials provide specific factual support for Opposer's allegation that the public associates Opposer and its Boston Marathon with "Marathon Monday" and that the mark MARATHON MONDAY would be recognized as pointing uniquely and unmistakably to the Opposer. The phrase MARATHON MONDAY does not have any other significant meaning.

As noted above, Opposer has provided numerous advertisements, announcements, and articles which connect the Boston Marathon, Opposer's publicly known identity, and Marathon Monday. Additionally, evidence has been provided that Opposer, through its licensees, provides the same type of goods as the Applicant seeks to provide under this mark. *See, Reg. No. 1832708* for the mark BOSTON MARATHON and *Opposer's Trial Exhibit 28*, for example. These materials provide specific factual support for opposer's allegations that MARATHON MONDAY and the Boston Marathon are well known and that the Opposer and others associate

the phrase MARATHON MONDAY with the public persona of the Opposer. In light of that evidence, a connection between the Applicant and the Opposer would be presumed when Applicant uses the mark MARATHON MONDAY for the goods cited in its application. *See, Buffett v. Chi-Chi's Inc.*, 226 USPQ 428, at 430.

An opposer in a proceeding of this character may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner. Opposer need not have controlled or commercially exploited the use of the term MARATHON MONDAY for the term to point uniquely and unmistakably to Opposer. *See, Notre Dame, id.* 217 USPQ at 508. Moreover, the fact that a few other parties have adopted the phrase in the very recent past does not negate the fact that the mark points uniquely and unmistakably to the Opposer, in fact, that is why parties have adopted the phrase MARATHON MONDAY. There is at least some evidence that other parties have adopted the phrase to play off of the reputation of the Boston Marathon. For example, see *Fleming Deposition Page 94, line 2 to Page 95, line 18*.

In the context of the Applicant's goods, it must be determined whether consumers for Applicant's goods would view the mark as pointing only to the Opposer, or whether they would perceive it to have a different meaning. Applicant has provided no explanation as to why it chose the mark MARATHON MONDAY. Although it is not the Applicant's burden to explain why it adopted its mark, Applicant's choice not to do so means there is no other explanation to show an alternative significance when used for the identified goods. *See, Hornby v. Tjx Companies Inc.*, 87 U.S.P.Q. 2d 1411 at 1427.

Applicant has not disputed that Opposer is not connected to the goods that are or will be sold by Applicant under its mark.

Applicant has also not disputed that it has not provided all of the goods listed in the description of goods of the application, despite filing an Amendment to Allege Use alleging use on all the goods.

Opposer has established that its identity is of sufficient fame or reputation that when applicant's mark is used on its goods, a connection with Opposer is presumed.

Fleming Deposition Exhibit 14 contains a dictionary definition from The Urban Dictionary.com of the term Marathon Monday and citing its connection to the Boston Marathon. The Court of Appeals for the Federal Circuit noted that “[w]hen a trademark attains dictionary recognition as part of the language, we take it to be reasonably famous.” *B.V.D. Licensing v. Body Action Design*, 846 F2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988).

The requirement which applies to “fame” in a false suggestion of a connection case is one of fame or reputation, rather than a strict fame requirement which may apply with respect to other grounds of an opposition. *Association Pour La Defense et La Promotion De L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838 (TTAB 2007). Based upon the goods cited in the Applicant's application and the evidence as to where the goods have been provided to date, it is clear that Applicant wished to trade on the Opposer's reputation and forge a connection between it and the Opposer's Boston Marathon to sell its products. Consumers encountering applicant's mark used in connection with the identified goods will associate the mark MARATHON MONDAY with Opposer's identity Marathon Monday.

VI. CONCLUSION

Based upon the reasons and case law set forth herein, Opposer's Notice of Opposition should be granted because refusal is warranted under Section 2(a) in that Applicant's mark creates a false suggestion of a connection with Opposer.

Respectfully submitted,



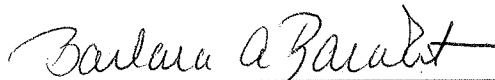
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CERTIFICATE OF SERVICE

It is hereby certified that the foregoing Reply Brief for Opposer was served by first class mail this 20th day of February 2014, upon:

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